

§103(a) Rejection of Claim 44

Claim 44 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Chou (US 5,142,123) ("Chou '123" hereafter) in view of Netherlands Patent No. 542,359 and Taiwanese Patent No. 040,687.

The Examiner alleges that a person of ordinary skill in the art would have been motivated to combine the teachings of the Netherlands patent and the Taiwanese patent with Chou '123. The Examiner further alleges that it would have been obvious to one of ordinary skill in the art to secure a metal press plate to a press bar of a hand-held electric sealer because "it has been held that rearranging parts of an invention involves only routine skill in the art," citing In re Japikse, a case dating back to 1950.

The applicant respectfully disagrees with the Examiner. The Examiner relies on impermissible hindsight to reconstruct the claimed invention from the prior art.

There is no suggestion in the references for the combination urged by the Examiner.

Further, even if combined, the claim at issue does not read on the combination.

Specifically, and as recognized by the Examiner, the references do not show "said metal

press plate is secured to said press bar." Thus, employing impermissible hindsight

reconstruction and lacking any support for the rejection, the Examiner relies on the

conclusory allegation that securing the metal press plate to the press bar (a feature not

shown in any of the references) is obvious because doing so is merely rearranging parts

of an invention, an act that involves "routine skill in the art." The Examiner does not

provide any support regarding motivation to "rearrange" the parts so that the metal press

plate is secured to the press bar rather than to the base of the electric sealer.

Claim 44 recites that "said metal press plate is secured to said press bar."

This allows an electric circuit to close when the press bar is pressed downward toward

the base because the metal press plate comes in contact with a switch which is partially

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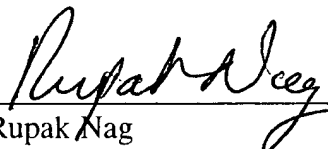
contained in the base. Hence, there are functional and performance motivations to securing the metal press plate to the press bar and does not qualify as merely rearranging parts of a device. Accordingly, the cited references alone or in combination do not show or suggest the invention as claimed. Since the distinctions are reflected in pending claim 44, applicant submits that the Examiner's 103(a) rejection should be withdrawn.

CONCLUDING REMARKS

In view of the foregoing remarks, it is believed that claim 44 is in condition for allowance. Reconsideration of the rejection and a notice of allowance are respectfully requested. Should there be any questions regarding this application, Examiner Van is invited to contact the undersigned attorney at the phone number listed below.

Respectfully submitted,

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Date



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